

09/877,835

6

P-5686U1-C1-1

REMARKS

Reconsideration of the present application and entry of the amendment is respectfully requested. Claims 1 to 9, 11 to 17, 19 and 20 are currently pending, and claims 1, 14 and 20 have been amended.

The Office Action mailed September 12, 2003 addressed claims 1 to 9, 11 to 17, 19 and 20. Claims 1 to 9, 11 to 17, 19 and 20 were rejected.

Claims 1 to 9, 11 to 17, 19 and 20 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner stated that the claim(s) contain subject matter which was not described in the specification in such a way to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner further stated that in claim 1, Applicant recites "...said cover layer includes at least one if (1)..., (ii)..., (iii), and (iv)..." wherein (i), (ii), (iii), and (iv) are different cover properties. The Examiner concluded that the language used by the applicant implies that the cover can meet all of (i), (ii), (iii), and (iv), and the same situation applies to claims 14 and 20.

Although Applicant respectfully disagrees with the Examiner, in an effort to hasten prosecution, Applicant has amended claims 1, 14 and 20 to delete the phrase "at least" from the claims. Applicant respectfully submits that this overcomes the rejection and requests that the Examiner reconsider and withdraw the rejection of claims 1 to 9, 11 to 17, 19 and 20 under 35 U.S.C. § 112, first paragraph.

Claims 1 to 3, 5 to 9, 11 to 16, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Melvin et al. (US 5,779,562) in view of Yamagishi et al. (US 5,688,595). The Examiner stated that Melvin et al. discloses a multi-core, multi-cover golf ball having a core comprised of a center core layer and an outer core layer and a cover comprised of an inner and outer cover layer. The Examiner further stated that the center core layer and the outer core layer are made of polybutadiene and may contain other thermoset materials, zinc diacrylate is the crosslinking agent, the center core layer has a diameter of about 10 to 35 mm, and the outer core layer has a diameter of 30 to 40 mm (and a thickness of 2.5 to 10 mm inherently). The Examiner further stated that the inner and outer cover layers both comprise ionomer resin, the inner cover layer is harder than the

09/877,835

7

P-5686U1-C1-1

outer cover layer wherein the inner cover layer has a Shore D hardness of 60 or more and the outer cover layer has a Shore D of 55 or less. The Examiner further stated that Melvin et al. does not disclose having a center component softer than the core layer, but Yamagishi et al. discloses a four piece golf ball having a dual core wherein the inner sphere is softer than the surrounding layer and the surrounding layer has a Shore D hardness of 45 to 80. The Examiner concluded that the core construction allows for improved restitution and soft hitting feel, and one of ordinary skill in the art would have found it obvious to have the inner sphere softer than the surrounding layer as taught by Yamagishi et al. in order to improve restitution and hitting feel.

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not made out a *prima facie* case of obviousness. Melvin et al. discloses a multi-core, multi-layer cover golf ball wherein the specific gravity of the inner core and the core layer are different by at least 0.1. Melvin et al. discloses that the moment of inertia of the ball can be controlled by changing the specific gravities of the inner core and core layer, depending on the desired moment of inertia. Melvin et al. does not disclose the hardness of the inner core, but Melvin et al. discloses that the outer cover layer is less than 55 Shore D and is also less than the inner core, and that the outer core has a Shore C of less than 80. Therefore, the inner core can be softer or harder than the core layer, as long as the specific requirements are met. Yamagishi et al. discloses a golf ball having a soft inner core, a hard core layer, and a soft cover wherein the inner cover layer is softer than the outer cover layer. The layers of Yamagishi's ball have specific properties to provide a specific feel and result. The cover layers of Yamagishi et al. are different from that of Melvin et al. because Melvin et al. has a hard inner cover layer and a soft outer cover layer, while Yamagishi et al. has a soft inner cover layer and a harder outer cover layer. Applicant respectfully submits that there is no motivation, suggestion or teaching to substitute the core of Yamagishi et al. for the core of Melvin et al. because Melvin et al. discloses that the core has specific properties designed to control the moment of inertia, and Yamagishi et al. has a harder outer core layer because of the softer cover. Additionally, Applicant respectfully submits that even if the core of Yamagishi et al. was substituted for the core of Melvin et al., Applicant's invention would not be disclosed.

09/877,835

8

P-5686U1-C1-1

For at least these reasons, Applicant respectfully submits that the rejection of claims 1 to 3, 5 to 9, 11 to 16, 19 and 20 under 35 U.S.C. § 103(a) has been overcome. Applicant therefore requests that the rejection of claims 1 to 3, 5 to 9, 11 to 16, 19 and 20 be reconsidered and withdrawn.

Claims 4 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Melvin et al. (US 5,779,562) in view of Yamagishi et al. (US 5,688,595) and further in view of Farrally et al. (Science and Golf III). The Examiner stated that Melvin et al. does not disclose the outer core layer having two or more layers, but Farrally et al. discloses that having a core more than two layers is advantageous in distributing the weight and specific gravity of the golf ball. The Examiner concluded that one having ordinary skill in the art at the time the invention was made would have found it obvious to incorporate a core layer with two or more layers in order to optimize the weight distribution and specific gravity of the golf ball.

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not made out a *prima facie* case of obviousness. As discussed above, Applicant respectfully submits that Melvin et al. in view of Yamagishi et al. does not disclose Applicant's invention. The addition of Farrally et al. also does not disclose Applicant's invention. Additionally, Applicant respectfully submits that Farrally et al. (on page 411) discloses that double cores, not a core with two or more layers, are advantageous. Contrary to the assertions of the Examiner, the reference does not comment on the advantage or disadvantage of having a core with two or more layers. Farrally et al. provides no motivation, suggestion or teaching for a core with a center and two or more layers.

For at least these reasons, Applicant respectfully submits that the rejection of claims 4 and 17 under 35 U.S.C. § 103(a) has been overcome. Applicant therefore requests that the rejection of claims 4 and 17 be reconsidered and withdrawn.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

09/877,835

9

P-5686U1-C1-1

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 1 to 9, 11 to 17, 19 and 20. Applicant respectfully requests allowance of claims 1 to 9, 11 to 17, 19 and 20, the claims currently pending.

Respectfully submitted,

R. DENNIS NESBITT

Customer No. 24492
Phone: (413) 322-2937

Date: December 9, 2003

By: Michelle Bugbee
Michelle Bugbee, Reg. No. 42,370
The Top-Flite Golf Company
A wholly-owned subsidiary of Callaway Golf Company
Attorney for Applicant
425 Meadow Street
P.O. Box 901
Chicopee, MA 01021-0901

cc: Richard M. Klein, Esquire (SLDZ 2 0214-3)